

Response Under 37 C.F.R. § 1.111  
U.S. Serial No. 08/988,181

Attorney Docket No.: Q48708

There is no disclosure or suggestion in Anderson that the box has features similar to the claimed indicating section for indicating performance characteristics of the golf ball as set forth in independent claim 12 (independent claim 31 recites similar features). In fact, the Examiner does not even contend that the claimed indicating section is present. The Examiner merely contends that indicia on a box is not patentable because it is not functionally related to the substrate (box). Office Action at page 2.

Applicant submits that the Examiner's position is entirely inappropriate since the issue of whether the claimed indicating section should be given patentable weight has already been decided in this application by the Board of Patent Appeals and Interferences. The Board has held the following:

**In the present case, a functional relationship clearly exists between the printed matter (the icons and sets of descriptive information relating to performance characteristics of the golf ball) and the substrate (the golf ball package). Thus, the printed matter limitations in the appealed claims must be evaluated in terms of their patentable weight in assessing the obviousness of the claimed invention.**

*Ex parte Shinichi Oshima*, Appeal No. 2002-1912 at page 7 (Bold added for emphasis). Here, the Examiner is clearly ignoring the holding of the Board in not considering the printed matter limitations in the claims. Accordingly, Applicant submits that the Examiner's rejection of claims 12-43 is improper and respectfully requests that the rejection be withdrawn.

## II. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

Response Under 37 C.F.R. § 1.111  
U.S. Serial No. 08/988,181

Attorney Docket No.: Q48708

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

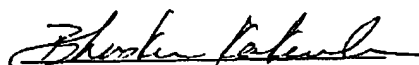
Respectfully submitted,

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

  
Bhaskar Kakarla  
Registration No. 54,627

Date: July 7, 2005